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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,683

08/05/2003

Hiroyuki Shindo

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6871

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05/10/2006

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EXAMINER

PATEL, GAUTAM

ART UNIT

PAPER NUMBER

2627

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/633,683

Applicant(s)

SHINDO, HIROYUKI

Examiner

Gautam R. Patel

Art Unit

2627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____                                                 |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____                                                                         | 6) <input type="checkbox"/> Other: ____                                     |

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### DETAILED ACTION

1. Claims 1-6 are pending for the examination.

#### Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. § 119(a)-(d), which papers have been placed of record in the file.

### NOTES & REMARKS

3. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. For example page 3, line 1, seems to be missing a letter "e", in the word "reflected".

- a. Also claim 3 ,line 1 has words "an second", making it grammatically incorrect. Applicant's cooperation is requested in correcting any errors of which Applicant may become aware in the specification.

- b. **The Applicants are urged to use proper 1449 form.**

#### Drawings/Objection

4. The drawings are objected for following reasons:

Figure(s) 2-3 are not designated by a legend such as "Prior Art". The legend is necessary in order to clarify what applicant's invention is (see MPEP § 608.02g).

Applicant is required to submit a proposed drawing correction in response to this Office Action. Any proposal by the applicant for amendment of the drawings to cure defects must consist of following:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be *accompanied by a marked-up copy of one or more of the figures being amended, with annotations*. Any replacement drawing sheet *must be identified in the top margin as "Replacement Sheet"* and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).*

a proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Correction may not be held in abeyance.

### **Specification**

5. The disclosure is objected for following reasons.

The title of the invention is neither precise nor descriptive. A new title is required which should include, using twenty words or fewer, claimed features that differentiate the invention from the Prior Art. It is recommended that the title should reflect the gist of or the improvement of the present invention.

The Applicants may want to consider changing word "replay" to "reproduce" in the specification and also in the claims for better understanding. Since word replay has a more conventional meaning of re-playing of sound or may be re-reading something, which of course is not happening here. The Examiner has noted that the Applicants have tried to change the word in one place to clarify what is really being claimed.

Corrections are required.

### **Claim Objections**

6. Claims 1-6 objected for following reasons.

It is not clear from the construction of the claim 1, what kind of an apparatus the applicants are trying to claim. The claim starts with words "a portion of peripheral rays ...". Thus not defining the apparatus that they are trying to claim.

Minor typographical error in claim 3, line 1 as explained above.

Corrections are required.

### **Claim Rejections - 35 U.S.C. § 102**

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if

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the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 are rejected under 35 U.S.C. § 102(e) as being anticipated by Motegi et al., US. patent 6.798,727 (hereafter Motegi).

As to claim 1, Motegi discloses the invention [optical pickup device] as claimed [see Figs. 1-5, especially 1 & 5] including a laser beam a first semiconductor laser element, a recording medium and a shaping prism, comprising:

a laser beam [fig.1, beam h1] emitted from a first semiconductor laser element [fig. 1, unit 2a] is incident upon a recording medium [fig. 2, unit marked CD, DVD] via a shaping prism [fig. 1, unit 9] in order to record or replay information, characterized in that: a portion of the peripheral rays emitted from the laser beam to be incident upon the shaping prism is incident upon the outer wall of the shaping prism, the reflected light thereof is guided into a light-receiving element [fig. 1, unit 15], and the output of light emitted from the first semiconductor laser element is controlled in accordance with the output signal of said light-receiving element [col. 4, line 6 to col. 5, line 28 & col. 7, lines 8-20, also col. 7, line 67 to col. 8, line 3].

8. The aforementioned claim 2, recites the following elements, inter alia, disclosed in Motegi:

a reflection means [fig. 1, unit 6] for making the laser beam emitted from the first semiconductor laser element reflect and guiding to the shaping prism; characterized in that said light-receiving element is arranged adjacent to said reflection means [col. 4, line 62 to col. 5, line 28].

9. The aforementioned claim 3, recites the following elements, inter alia, disclosed in Motegi:

a second semiconductor laser element [fig. 1, unit 3, characterized in that record or replay of information is carried out by making the laser beam emitted from said first semiconductor laser element incident upon the recording medium via said shaping prism; and

record or replay of information is carried out by making the laser beam emitted from said second semiconductor laser element incident upon the recording medium via said shaping prism [col. 4, line 6 to col. 5, line 28 & col. 7, lines 8-20, also col. 7, line 67 to col. 8, line 3].

10. The aforementioned claim 4, recites the following elements, inter alia, disclosed in Motegi:

the first semiconductor laser element is utilized when recording information to, or replaying information from a high-density recording disk [DVD]; and

the second semiconductor laser element is utilized when recording information to, or replaying information from a low-density recording disk [CD] [col. 4, line 6 to col. 5, line 28 & col. 7, lines 8-20, also col. 7, line 67 to col. 8, line 3; also col. 8, lines 34-46].

11. The aforementioned claim 5, recites the following elements, inter alia, disclosed in Motegi:

said shaping prism further having an incidence portion on which the laser beam emitted from the first semiconductor laser element is incident and a reflection portion whereby the laser beam emitted from the second semiconductor laser element is reflected: characterized in that a portion of the peripheral rays of the laser beam is reflected at the outer wall between said incidence portion and said reflection portion; and the reflected light thereof is guided to the light-receiving element [col. 4, line 6 to col. 5, line 28 & col. 7, lines 8-20, also col. 7, line 67 to col. 8, line 3; also col. 8, lines 34-46].

12. The aforementioned claim 6, recites the following elements, inter alia, disclosed in Motegi:

a reflection means [fig. 1, unit 6] is provided whereby the laser beam emitted from the first semiconductor laser element is reflected and guided to the shaping prism; the laser beam emitted from the first semiconductor laser element forms a V-shaped locus by being reflected through the reflection means to reach the shaping prism; and of the small angle and large angle specified for said laser beam's V-shaped locus, said light-receiving element is positioned on the same side as the large angle [col. 4, line 6 to col. 5, line 28 & col. 7, lines 8-20, also col. 7, line 67 to col. 8, line 3; also col. 8, lines 34-46].

**Other prior art cited**

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a) Noguchi et al. (US. Patent 5309423)
- b) Shinoda et al. (US. patent 5469423)
- c) Whitehead (US. patent 5311496)
- d) Ishika et al. (US. patent 5781519)


**Contact information**

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is 571-272-7625. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2650) where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dwayne Bost, who can be reached on (571) 272-7023.

Any inquiry of a general nature or relating to the status of this application should be directed to the Electronic Business Center whose telephone number is 866-217-9197 or the USPTO contact Center telephone number is (800) PTO-9199.

  
**PRIMARY EXAMINER**

Gautam R. Patel  
Primary Examiner  
Group Art Unit 2627

May 6, 2006